

**REMARKS**

Claims 1-9 are pending in the application.

Claims 1-9 have been previously rejected.

No pending Claims have been amended, and reconsideration is respectfully requested in light of the following arguments and remarks.

New Claims 10-13 have been added.

I. REJECTIONS UNDER 35 U.S.C. § 103

Claims 1-4 and 7-8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Zaki (US Patent No. 7,164,915) in view of Friday, et al. (US Patent Application Publication No. 2006/0187873).

Claims 5-6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Zaki (US Patent No. 7,164,915) in view of Friday, et al. (US Patent Application Publication No. 2006/0187873) and further in view of Astarabadi (US Patent Application Publication 2005/0138178).

Claim 9 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Zaki (US Patent No. 7,164,915) in view of Astarabadi (US Patent Application Publication 2005/0138178) and further in view of Davi (“Alternative Wireless”).

The rejections are respectfully traversed.

With respect to Claims 1-8, in Applicant’s prior response, independent Claims 1, 3 and 7 were amended to recite “receiving from the first access point the roaming candidate list identifying the plurality of candidate access points in the WLAN.” And, independent Claim 5 was amended to recite “wherein the roaming candidate list identifying the plurality of candidate access points in the WLAN is received from the first access point.”

The Office Action concedes that Zaki fails to disclose each of these elements/features (see, Office Action, p. 3, 8) but argues that Friday teaches these elements/features, and it would be obvious to incorporate the teachings of Friday in the system of Zaki (or Zaki and Astarabadi).

The U.S. filing date of the Friday reference is July 15, 2005, and which claims an effective priority date of February 18, 2005 (by its claim of priority to US provisional application 60/654,621). The instant application has a filing date of December 16, 2005, but has an effective priority date of December 16, 2004 – which is earlier than the priority date of the Friday reference. Therefore, the Friday reference is unavailable as prior art against the instant application. For reference, Applicant directs the Examiner's attention to Applicant's US Provisional Patent Application Serial No. 60/636,741, particularly pages 38-39 and 1-5, which describe the client/terminal receiving a roaming candidate list from an access point. Therefore, the roaming candidate list feature/element as recited in the claims has priority to at least December 16, 2004.

Applicant herewith submits a copy of the Request To Correct Inventorship In A Provisional Application Under 37 C.F.R. §1.48(d) filed on August 5, 2009 in US Provisional Application Serial No. 60/636,741. As of October 30, 2009, the Office has not yet acted on this Request, and therefore, the Examiner is respectfully requested to delay examination until the Request is acted upon by the Office.

Based on the foregoing, Claims 1-8 are patentable over the cited references, and this response overcomes the rejections of Claims 1-8.

With respect to Claim 9, and as set forth in Applicant's prior response, original Claim 9 recites that "the access points in a first cell are operable for transmitting a roaming candidate list to a mobile device associated with one of the access points in the first cell, the list identifying one or more neighborhood access points." The Office Action points to Astarabadi (Figure 2, #450, Figure 3, #458 and Col. 3, paragraph 0041) as teaching this element/feature. Applicant respectfully disagrees. This portion of Astarabadi merely describes that the "AP list" may be downloaded. What APs are identified in this list is undetermined. Applicant's list is a list of roaming candidates. Astarabadi does not disclose this. In fact, reference to Astarabadi, Col. 3, paragraph 0036, confirms that the "AP list" is provide to the wireless station upon initial login, and the list includes "each AP to which a user of the wireless station has access privileges." Thus, Applicant submits that the AP list initially downloaded to the wireless station in Astarabadi is not a "roaming candidate list" as that

term is used and described in Applicant's specification. The Davi reference fails to cure the noted deficiencies in Zaki and Astarabadi, therefore, the proposed combination of Zaki-Astarabadi-Davi fails to render obvious Claim 9.

Based on the foregoing, Claim 9 is patentable over the cited references, and this response overcomes the rejection of Claim 9.

II. NEW CLAIMS 10-13

New Claims 10-13 have been added which depend from independent Claims 1, 3, 5 and 7, respectively, and Applicant respectfully submits these claims are patentable for the same or similar reasons as set forth above.

III. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *rmccutcheon@munckcarter.com*.

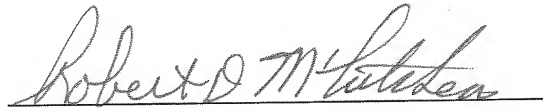
The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Nortel Networks Deposit Account No. 14-1315.

Respectfully submitted,

MUNCK CARTER, LLP

Date: \_\_\_\_\_

10/30/2009



Robert D. McCutcheon  
Registration No. 38,717

P.O. Drawer 800889  
Dallas, Texas 75380  
(972) 628-3632 (direct dial)  
(972) 628-3600 (main number)  
(972) 628-3616 (fax)  
E-mail: *rmccutcheon@munckcarter.com*

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**Acknowledgement Receipt**

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The USPTO has received your submission at **16:36:52** Eastern Time on **05-AUG-2009** by Deposit Account: 141315.

\$ **50** fee paid by e-Filer via *RAM* with Confirmation Number: 3129.

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**eFiled Application Information**

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EFS ID	5835185
Application Number	60636741
Confirmation Number	7269
Title	High performance WLAN mobile adapter
First Named Inventor	William Douglass
Customer Number or Correspondence Address	21498
Filed By	Robert D. McCutcheon/Keith Woods
Attorney Docket Number	17517RRUS01P
Filing Date	16-DEC-2004
Receipt Date	05-AUG-2009
Application Type	Provisional

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**Application Details**

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Submitted Files	Page Count	Document Description	File Size	Warnings
RequestForCorrectedInventorship.pdf	5	Request under Rule 48 correcting inventorship	187032 bytes	◆ PASS
fee-info.pdf	2	Fee Worksheet (PTO-875)	29954 bytes	◆ PASS

This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

**New Applications Under 35 U.S.C. 111**

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

**National Stage of an International Application under 35 U.S.C. 371**

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

**New International Application Filed with the USPTO as a Receiving Office**

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in

due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

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- *Send general questions about USPTO programs to the [USPTO Contact Center \(UCC\)](#).*
- *If you experience technical difficulties or problems with this application, please report them via e-mail to [Electronic Business Support](#) or call 1 800-786-9199.*

DOCKET NO. 17517RRUS01P (NORT10-000499)  
Customer No. 33000

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : William Douglass, et al.  
Serial No. : 60/636,741  
Filed : December 16, 2004  
For : HIGH PERFORMANCE WLAN MOBILE ADAPTER  
Group No. : N/A  
Examiner : N/A

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**REQUEST TO CORRECT INVENTORSHIP IN A PROVISIONAL APPLICATION**  
**UNDER 37 C.F.R. §1.48(d)**

Applicants in the above United States provisional patent application hereby request that the Commissioner correct inventorship to add Tarek Ibrahim of Hoboken, New Jersey, John Brancato of Tappan, New York and John Bongiorno of Litchfield, Connecticut under 37 C.F.R. §1.48(d), as inventors in this application.

As a result, the following inventors for the above-identified provisional application should be added:

Tarek Ibrahim, Hoboken, New Jersey  
John Brancato, Tappan, New York  
John Bongiorno, Litchfield, Connecticut

Attached hereto, and which form part of this Request, are the Statements of Tarek Ibrahim, John Brancato and John Bongiorno stating that the inventorship error occurred without any deceptive intention on his part.

Accordingly, the Applicants request the Patent Office grant the instant Request to Correct Inventorship In a Provisional Application Under 37 C.F.R. §1.48(d).

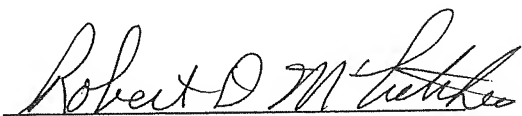
Please charge the fee of \$50.00 associated with this Request to Nortel Networks Deposit Account No. 14-1315.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *rmccutcheon@munckcarter.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Nortel Networks Deposit Account No. 14-1315.

Respectfully submitted,  
MUNCK CARTER, LLP

Date: 8/5/2009

  
Robert D. McCutcheon  
Reg. No. 38,717

P.O. Box 802432  
Dallas, Texas 75380  
Phone: (972) 628-3600  
Fax: (972) 628-3616  
E-mail: *rmccutcheon@munckcarter.com*

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Group No. : N/A  
Examiner : N/A

STATEMENT OF TAREK IBRAHIM

I, Tarek Ibrahim, declare:

I am entitled to be listed as an inventor on the above application, and accordingly request that I be added as a joint inventor. The inventorship error of failing to include me as an inventor of the patent occurred without any deceptive intention on my part.

All statements made herein of my own knowledge are true and made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the above patent.

4 / 11 / 2006  
\_\_\_\_\_  
Date

  
\_\_\_\_\_  
Tarek Ibrahim

DOCKET NO. 17517RRUS01P (NORT10-000499)  
Customer No. 33000

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For : HIGH PERFORMANCE WLAN MOBILE ADAPTER  
Group No. : N/A  
Examiner : N/A

STATEMENT OF JOHN BRANCATO

I, John Brancato, declare:

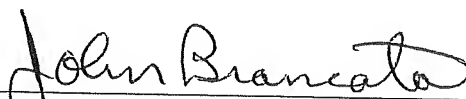
I am entitled to be listed as an inventor on the above application, and accordingly request that I be added as a joint inventor. The inventorship error of failing to include me as an inventor of the patent occurred without any deceptive intention on my part.

All statements made herein of my own knowledge are true and made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the above patent.

Date

4/7/2006

John Brancato

  
John Brancato

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Group No. : N/A  
Examiner : N/A

STATEMENT OF JOHN BONGIORNO

I, John Bongiorno, declare:

I am entitled to be listed as an inventor on the above application, and accordingly request that I be added as a joint inventor. The inventorship error of failing to include me as an inventor of the patent occurred without any deceptive intention on my part.

All statements made herein of my own knowledge are true and made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the above patent.

April 14, 2006  
Date

John P. Bongiorno  
John Bongiorno